

REMARKS

Claims 8, 13 and 21 have been amended to correct the 35 U.S.C. §112 problem by deleting “and the like”. This should obviate that rejection of those claims as well as the noted dependent claims.

Reconsideration of this application is respectfully requested.

In rejecting all of Applicant’s claims in shotgun fashion, the Examiner seems to have combined concepts from normally unrelated arts.

There are literally scores of patents relating to slip on nuts. Most of them involve carefully machined thread conforming moving parts. Push-on spring nuts date back to the second world war. The cited Tinnerman patent was filed in 1943. This Tinnerman patent issued in 1944 and was cited against Kies. Copies of the art cited in Kies confirms this classification. It also confirms that no beam clamp such as Havener was cited against Kies.

Also, the Havener patent issued some thirty-eight years ago on an application filed forty years ago.

Havener shows one embodiment with a clearance hole 41 for a threaded rod 71 supported on top of the clamp by a conventional washer 72 with a conventional nut 73 providing vertical adjustability (Col. 3, lines 55-57). During a number of decades of coexistence, Havener didn’t look to Tinnerman’s art (Kies) nor has the slip-on-nut art looked to beam clamps.

That is until now. The Examiner seems to have no problem with this cross direction, but obviously only after reading and understanding applicants invention.

The Examiner has simply taken a concept from one art and applied it to another following Applicant's teaching. The fact that Havener doesn't begin to provide the plain side walls, or the space for two slots to receive a clip and still grasp the threads, or the guides or back-ups necessary for a real world device, is of no concern, especially when only unrelated concepts are combined.

A leading oft cited authority on this subject is *In re Otiker* 24 USPQ 2nd 1443 (CAFC 1992), and at 446 the Court indicated:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) -- in other words, common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ 2d 1315, 1318 (Fed. Cir. 1988); *In re Gieger*, 815 F.2d 686, 687, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil* 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985).

[5] Oetiker's invention is simple. Simplicity is not inimical to patentability. *See Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 60 USPQ 386, 388 (1944) (simplicity of itself does not negative invention); *Panduit Corp. v. Dennison Mfg Co.*, 810 F.2d 1561, 1572, 1 USPQ 2d 1593, 1600 (Fed. Cir.) (the patent system is not foreclosed to those who make simple inventions), *cert. denied*, 481 U.S. 1052 (1987).

We conclude that the references on which the Board relied were improperly combined. Accordingly, the Board erred in holding the claims unpatentable under section 103. The rejection of claims 1-4 and 16-21 is

REVERSED.

The Examiner, using only hindsight seems to be blazing a trail in relating the two different concepts, but could one skilled in the art accomplish the claimed invention without the blueprint of this application? For decades those skilled in the art did not. The answer is no.


The Examiners reference to the pipe or conduit bracket of Havener seen in Figures 7 and 8, and described in detail at column 3, lines 17-29, and turning it into a edge clip extension is simply a good example of the hindsight reconstruction of the prior art following Applicant's blueprint.

Applicants claims are submitted as patentable over the applied art as well as the other art of record, but not applied.

In view of the foregoing, this application is submitted as in condition for final allowance and early action to that effect is respectfully requested.

Should any deficiencies or overpayments occur in the filing fees of the subject amendment, authorization is hereby given to charge Deposit Account Number 18-0988.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "John W. Renner", written over a horizontal line.

John W. Renner

Reg. No, 19,097

RENNER, OTTO, BOISSELLE & SKLAR
1621 Euclid Avenue, 19th Floor
Cleveland, Ohio 44115

PHONE: (216) 621-1113
FAX: (216) 621-6165